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**RENEWED PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

First : Robert Bruce Spertell
Named
Inventor
App. No : 09/637,923
Filed : August 14, 2000
Title : Method and Apparatus for Treating
Subcutaneous Histological Features
Examiner : Fadi H. Dahbour
Art Unit : 3742
Petitions : Sherry D. Brinkley
Examiner

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Bryan Wahl, Reg. No. 58,878

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

In response to the Decision on Petition mailed 5/30/08, Applicant submits herewith a Renewed Petition for Revival of the above-captioned abandoned application under 37 C.F.R. 1.137(b), along with a request for a two-month extension of time. In addition, factual declarations are provided from the following individuals: Douglas Hanscom, Raymond Bogucki, Grace Sim, Jan Wallace, Mark Deem and Bryan Wahl, who are all individuals having firsthand knowledge of the circumstances of the application during the relevant time periods as evidence of unintentional delay pursuant to 37 C.F.R. 1.137(b).

Remarks begin on page 2 of this paper.

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REMARKS

The above-identified application became abandoned on September 6, 2002. The application became abandoned for Applicant's failure to timely file a reply to an Office Action mailed June 5, 2002, having a shortened period of response of September 5, 2002. Applicant filed a Petition for Revival for an application unintentionally abandoned under 37 C.F.R. 1.137(b) on March 7, 2008. A Decision on Petition dismissing the Petition for Revival was mailed on May 30, 2008.

Summary of Decision of Petition

In the Decision on Petition mailed on May 30, 2008, the Examiner dismissed Applicant's Petition for Revival, finding there was not a satisfactory showing of unintentional delay. Decision on Petition at p. 2. The Examiner found that the Applicant must show that the delay was unintentional for two periods: (1) the delay in reply that originally resulted in the abandonment and (2) the delay in filing an initial petition pursuant to 37 C.F.R. 1.137(b) to revive the application. Id.

Chain of Title

This Renewed Petition for Revival is filed on behalf of the current assignee of the above-identified application, Miramar Labs, Inc., who acquired title as follows. The above-identified application is a divisional application of U.S. Patent No. 6,104,959 (the "'959 Patent") to Robert B. Spertell. The '959 Patent was assigned from Mr. Spertell to Microwave Medical Corporation. Exhibit 9. The assignment document expressly assigned all divisional applications, including the above-identified application, to Microwave Medical Corporation, and was recorded in the United States Patent and Trademark Office on July 31, 2007 at Reel 008662 and Frame 0965. Exhibit 9.

Microwave Medical Corporation was a wholly-owned subsidiary of MW Medical, Inc. On January 22, 2002, both companies filed for Chapter 11 bankruptcy in the District Court of Arizona (Case Nos. 02-01090-ECF-RTB and 02-01298-ECF-GBN). Exhibit 11. In part because Microwave Medical Corporation was a wholly-owned subsidiary of MW Medical, Inc., the bankruptcy cases were consolidated, as were the assets of the two companies. Exhibit 11. A sole

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successor company, MW Medical, Inc., emerged from the bankruptcy proceedings on November 19, 2002 as the owner of all intellectual property assets of Microwave Medical Corporation and MW Medical, Inc., including the above-identified application. Exhibit 11.

Based on an unrecorded assignment agreement effective March 15, 2003, MW Medical, Inc. assigned all rights to its intellectual property on its books, including the above-identified application, to Jan Wallace, who had served as Chief Executive Officer of MW Medical, Inc. Decl. of Wallace at p. 2; Exhibit 13. Ms. Wallace subsequently assigned her rights to the above-identified application to Miramar Labs, Inc. by virtue of an unrecorded assignment dated January 24, 2008. Id. at 3; Exhibit 14.

Establishment of Unintentional Delay

Under 35 U.S.C. section 41(a)(7), a Director may accept a petition “for the revival of an unintentionally abandoned application for a patent.” While the petition must be accompanied by a statement that the delay was unintentional, the Director “may require additional information where there is a question whether the delay was unintentional.” 37 C.F.R. 1.137(b)(3).

The Examiner has requested additional information from Applicant to establish unintentional delay, and has expressed that the Applicant must show that the delay was unintentional for two periods: (1) the delay in reply that originally resulted in the abandonment and (2) the delay in filing an initial petition pursuant to 37 C.F.R. 1.137(b) to revive the application. Decision on Petition at p. 2. With respect to period (1), a petition for revival must clearly identify the party having the right to reply to avoid abandonment on September 6, 2002, and that party must explain what effort was made to reply to the outstanding Office Action and why no reply was filed. Id. at p. 3. If no effort was made to further reply to the Office Action, the party must explain why the delay in the application does not result from “a deliberate course of action (or inaction).” Id. With respect to period (2), a petition for revival must provide a “detailed explanation seeking to excuse the delay” in filing a petition for revival as opposed to a general allegation of unintentional delay. Id. at p. 4.

Applicant submits that both of the following delays were unintentional: (1) the delay in reply that originally resulted in the abandonment and (2) the delay in filing an initial petition pursuant to 37 C.F.R. 1.137(b) to revive the application.

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(1) The delay in reply that originally resulted in the abandonment was unintentional.

The above-identified application became abandoned on September 6, 2002 for failure to reply to an Office Action mailed on June 5, 2002. At the date of abandonment, the application was assigned to Microwave Medical Corporation.

Applicant submits that the delay in reply that originally resulted in the abandonment was unintentional because Grace Sim, the Microwave Medical Corporation and MW Medical, Inc. officer who had sole authority regarding the intellectual property for the companies had no knowledge of the abandonment of the application. Ms. Sim was the contact person at both Microwave Medical Corporation and MW Medical, Inc. (which shared virtually the same management team), and was responsible for making decisions regarding both companies' intellectual property. Ms. Sim was unsophisticated in patent law and was unaware that an Office Action had even been mailed because all correspondence mailed during the Office Action response period from the patent attorneys was returned to sender. Decl. of Sim at p. 3. Although Microwave Medical Corporation did retain patent attorneys to prosecute the above-mentioned application, the attorneys were unable to establish contact with Ms. Sim to inform her of the outstanding Office Action despite several attempts at making contact, and therefore, no response was filed to the Office Action.

Two attorneys were responsible for the prosecution of the application, Raymond Bogucki, a solo practitioner, and Douglas Hanscom of the law firm Jones, Tullar & Cooper, PC. Decl. of Hanscom at p. 2. Mr. Bogucki and Mr. Hanscom were the only attorneys having firsthand knowledge of the prosecution of the application. Id.

While Mr. Bogucki was co-counsel during the prosecution of the application, Mr. Hanscom and his firm handled all filings, docketing, and receipt of Patent Office correspondence for the application. Decl. of Hanscom at p. 2. Mr. Hanscom sent correspondence to Ms. Sim the contact person responsible for all intellectual property for Microwave Medical Corporation and MW Medical, Inc., at the business address of 6617 N. Scottsdale Road, Suite 103, Arizona 85253. Id. During the prosecution of the application, Mr. Hanscom also sent copies of correspondence to Mr. Bogucki. Id.

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Mr. Hanscom received a non-final Office Action from the United States Patent and Trademark Office (USPTO) that was mailed June 5, 2002. Decl. of Hanscom at p. 2. On June 12, 2002, Mr. Hanscom sent a cover letter and a copy of the Office Action via First Class Mail to Ms. Sim at the aforementioned business address. Id. At some point between June 12 and June 19, 2002, the letter and Office Action were returned by the post office and marked "Return to Sender" with the reason for non-delivery circled as "Expired Order." Id. at p. 3. The address was the only address Mr. Hanscom had on file, and neither he nor Mr. Bogucki had any other address or working telephone number to contact Ms. Sim. Id. and Decl. of Bogucki at p. 4. Up until the date of abandonment on September 6, 2002 (and beyond as discussed below), Mr. Hanscom and Mr. Bogucki attempted to contact Ms. Sim by various methods, but were not successful. Decl. of Hanscom at p. 3 and Decl. of Bogucki at p. 4. As both attorneys were under the impression that MW Medical, Inc. was defunct and neither attorney had any means to communicate with their client so as to receive instructions on how to proceed with the application, no response was filed to the Office Action, and the application was abandoned on September 6, 2002. Decl. of Hanscom at p. 3 and Decl. of Bogucki at p. 4.

Ms. Sim did not receive the letter sent from Mr. Hanscom on June 12, 2002. Decl. of Sim at p. 3. While Mr. Hanscom was provided with the correct business address in Scottsdale, AZ for corresponding with Ms. Sim, the Scottsdale, AZ headquarters was vacated around April 2002 due to cost considerations. Id. By January 22, 2002, both MW Medical, Inc. and Microwave Medical Corporation had already filed for Chapter 11 bankruptcy. Id. Due to a myriad of issues surrounding bankruptcy at the time, a forwarding address may not have been provided to the patent attorneys. Id.

Ms. Sim was unsophisticated in patent law and relied heavily on the advice of the patent attorneys for guidance. Decl. of Sim at p. 3. As Ms. Sim never received any letter or communication from Mr. Hanscom regarding the Office Action, she was unaware that the application would be abandoned on September 5, 2002. Id. Had she received the communication from Mr. Hanscom, she would have instructed him to respond to the Office Action. Id.

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(2) The delay in filing an initial petition pursuant to 37 C.F.R. 1.137(b) to revive the application was unintentional.

The above-identified application became abandoned on September 6, 2002. A Petition for Revival of the application under 37 C.F.R. 1.137(b) was filed on March 7, 2008. Between September 6, 2002 (the date of abandonment) and March 7, 2008 (the date of filing a grantable Petition for Revival), the application was assigned to three different parties in the following order: Microwave Medical Corporation (which became MW Medical, Inc. following emergence from bankruptcy), Jan Wallace and Miramar Labs.

Applicant submits that the delay in filing an initial petition pursuant to 37 C.F.R. 1.137(b) to revive the application was unintentional because the former assignees, Microwave Medical Corporation and Jan Wallace, had no knowledge of the abandonment of the application until late 2007 when the current assignee, Miramar Labs, sought to acquire the assets from the former assignees. The representatives of the former assignees having authority to make intellectual property decisions were unsophisticated in patent law and believed that all patents formerly belonging to Microwave Medical Corporation had issued. Although patent attorneys were retained by the first assignee, Microwave Medical Corporation, to prosecute the above-mentioned application, the attorneys were unable to communicate with their client and inform the client that the application had gone abandoned on September 6, 2002. As the attorneys were unable to communicate with their client, they were unaware of the assignment from MW Medical, Inc. (the sole successor company emerging from bankruptcy) to Jan Wallace following bankruptcy proceedings, and were unable to convey to Ms. Wallace that the application had gone abandoned. Ms. Wallace did not inform Mr. Hanscom nor Mr. Bogucki of the assignment to her. It was not until late 2007 that Ms. Wallace became aware of the abandonment of the application and diligent efforts to revive the application began.

A. Assignee Microwave Medical Corporation: September 6, 2002 – March 15, 2003

Ms. Sim, who was responsible for the intellectual property of assignee, was not aware of the abandonment of the application on September 6, 2002. Decl. of Sim at p. 3. Ms. Sim, who was unsophisticated in patent law, did not receive any notice regarding the Office Action, due to the vacating of the Scottsdale, AZ headquarters because of financial reasons. Id. at p. 2. She was unaware that the patent had gone abandoned on September 6, 2002, and did not seek to file a

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petition to revive the application while Microwave Medical Corporation was the assignee. Decl. of Sim at pp. 3.

After the abandonment of the application, Mr. Bogucki and Mr. Hanscom attempted repeatedly to communicate with Ms. Sim, but were unsuccessful at establishing contact. Decl. of Hanscom at p. 3. and Decl. of Bogucki at p. 4. After numerous failed attempts to contact Ms. Sim, no further action was taken to revive the abandoned application. Decl. of Hanscom at p. 4 and Decl. of Bogucki at p. 4. As neither Mr. Bogucki nor Mr. Hanscom had received any instructions on how to proceed with the application, neither believed that he was in a position to revive the abandoned application on his own. Decl. of Hanscom at p. 3 and Decl. of Bogucki at p. 4.

B. Assignee Jan Wallace: March 15, 2003 – January 24, 2008

On January 22, 2002, MW Medical, Inc. and its wholly-owned subsidiary Microwave Medical Corporation filed for Chapter 11 bankruptcy in the District Court of Arizona. Decl. of Wallace at p. 2. The two bankruptcy cases were consolidated, as were the assets and claims of the two entities, and a single successor company, MW Medical, Inc. emerged from the bankruptcy. Id. At the close of the bankruptcy proceedings, Ms. Wallace, who had personally loaned a substantial sum of money to MW Medical, Inc. and Microwave Medical Corporation to finance their operations, was the largest creditor of the successor company. Id. On March 21, 2003, MW Medical, Inc. assigned all of its intellectual property rights (including the above-identified application) and other assets to Ms. Wallace in exchange for a reduction in the amount of debt that was owed to her. Id.

At the time that the intellectual property had been assigned to Ms. Wallace on March 21, 2003, Ms. Wallace, who had minimal experience with the patent process, believed that no further action was required to keep them in force. Decl. of Wallace at p. 2. Ms. Sim, who was aware that the intellectual property rights had been assigned from MW Medical, Inc. to Ms. Wallace, believed that she was no longer responsible for managing the intellectual property, including the above-mentioned application. Decl. of Sim at p. 3. Therefore, neither Ms. Wallace, who believed the application had issued, nor Ms. Sim, who no longer felt responsible for the application following the assignment to Ms. Wallace, sought to revive the application after the

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assignment to Jan Wallace until receiving notice of the abandonment of the application in late 2007.

By the time the above-mentioned application had been assigned to Ms. Wallace, Mr. Bogucki and Mr. Hanscom were under the belief that MW Medical, Inc. was defunct. Decl. of Hanscom at p. 3 and Decl. of Bogucki at p. 4. Nonetheless, both Mr. Bogucki and Mr. Hanscom persisted in trying to contact Ms. Sim by various methods of communication, including letter and telephone, long after the intellectual property rights were assigned to Ms. Wallace. Decl. of Hanscom at p. 3 and Decl. of Bogucki at p. 4. For example, without any knowledge of the assignment of intellectual property rights from MW Medical, Inc. to Ms. Wallace, Mr. Hanscom continued to forward correspondences to the Scottsdale, AZ address of MW Medical, Inc. well beyond the date of assignment to Ms. Wallace without success. Decl. of Hanscom at p. 3. As neither Mr. Bogucki nor Mr. Hanscom had received any instructions on how to proceed with the application, neither believed that they had the authorization to revive the abandoned application on his own. Decl. of Hanscom at p. 3 and Decl. of Bogucki at p. 4.

C. Assignee Miramar Labs: January 24, 2008 – present

In 2007, Mark Deem, Chief Executive Officer of Miramar Labs, Inc., an early stage private medical device company, was researching intellectual property of potential interest to Miramar Labs, the current assignee of the above-mentioned application. Decl. of Deem at p. 1. Around August 2007, Mr. Deem came across U.S. Patent No. 6,104,959, the parent application of the above-identified application. Id. After performing due diligence into the ownership of the patent, Mr. Deem discovered the existence of the above-identified application. Id. Though the status of the above-identified application was not clear, Mr. Deem instructed his intellectual property counsel, Sabin Lee and Bryan Wahl of Knobbe, Martens, Olson & Bear LLP to further research the status of the above-identified application. Id. at p. 2. Based on the file history, Mr. Deem's counsel determined that the application had gone abandoned on September 6, 2002 for failure to respond to an Office Action. Id.

Through further research into the Security and Exchange Commission databases, Mr. Deem discovered the assignment agreement effective March 15, 2003 that assigned the intellectual property rights of MW Medical, Inc. to Ms. Wallace. Decl. of Deem at p. 2. Mr. Deem contacted Ms. Wallace around November 2007 regarding the possibility of acquiring her

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intellectual property assets, including the rights to the above-identified application. Id. After several discussions, Mr. Deem discovered that Ms. Wallace was completely unaware that the above-identified application had gone abandoned. Id. After obtaining Ms. Wallace's consent, Mr. Deem contacted the attorneys who he found to be involved with prosecution of the above-identified application, including Mr. Bogucki and Mr. Hanscom. Id. He learned that both attorneys had been unable to reach their client, and that both attorneys were completely unaware that the application had been assigned to Ms. Wallace in 2003. Id.

After an extended period of negotiations lasting from November 2007 until January 2008, Ms. Wallace assigned her rights to the above-mentioned application to Miramar Labs by virtue of an assignment agreement dated January 24, 2008. Decl. of Deem at p. 3. Immediately thereafter, Mr. Deem instructed Miramar Labs' counsel Mr. Lee and Mr. Wahl to prepare a petition to revive the abandoned application and to contact potentially relevant parties including Mr. Bogucki, Mr. Hanscom, Ms. Wallace and Ms. Sim to support revival of the application. Id. Upon reviewing the file history of the above-mentioned application and interviewing the aforementioned individuals, Mr. Lee and Mr. Wahl determined that the present application was abandoned unintentionally, and diligently prepared a petition to revive an application unintentionally abandoned under 37 C.F.R. 1.137(b), along with the requisite amendment and response to the Office Action mailed June 5, 2002. Id. A Petition for Revival was filed with the USPTO on March 7, 2008. Id.

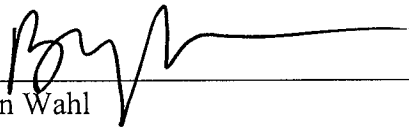
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Conclusion

For the reasons presented above, Applicant respectfully submits that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and hereby requests revival of the application. If any issues remain, the Examiner is cordially invited to contact Applicant's representative at the number provided below in order to resolve such issues promptly.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/30/08

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